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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,210	06/24/2003	David B. Griep	066042-9326-00	2237
23409	7590	05/22/2006	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER

3724

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,210

Applicant(s)

GRIEP ET AL.

Examiner

Kenneth E. Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-33,36,37,39-41,44-49,51-56,58,60-63 and 65-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-33,36,37,39-41,44-49,51-56,58,60-63 and 65-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-28,30-33,36,37,39-41,44-49,51-56,58,60-63 and 65-67 are rejected under 35 U.S.C. 103(a).

It is old and well known for reciprocating saws to have all of the recited limitations except the elastic force transmitter. An example of this is the patent to Butz '685, and there are numerous other reciprocating saws that could be used in lieu of Butz for the purpose of this rejection.

Butz does not have an elastic force transmitter, but such is well known in the art of reciprocating saws, as shown by Palm '023 in figure 7. Palm shows an externally toothed inner hub (710) and an internally toothed outer gear (716) having a plurality of elastic rubber elements positioned between the interacting teeth. Examiner notes that Palm's gear teeth and hub teeth do not radially overlap, but Applicant has not claimed this.

It would have been obvious to one of ordinary skill in the art to have modified Butz by providing his gear (40) with an elastically connected internal hub, as taught by Palm, in order to extend the life of the tool (Palm's lines 41-47, column 6). After this modification, Butz's elements 24 and 29 would be as one with the inner hub, and thus the inner hub would have an eccentric output member (29).

The following is seemingly unnecessary, but if there is any doubt about the obviousness of placing the elastic force transmitter between Butz's gear (40) and output member (29), then attention is drawn to figure 2 of the patent to Knight '813, who shows selective force transmittal between the gear (116) and the output member (125).

3. Claims 20-33,36,37,39-41,44-49,51-56,58,60-63 and 65-67 are rejected under 35 U.S.C. 103(a).

The below specifically addresses claims 29,50,57 and 64, but is pertinent to all the claims that address the elastic force transmitter.

Butz, as modified above, has an elastic force transmitter that is not a body with a plurality of elastic protrusions thereon. However, such is well known as taught by King et al.'368 and/or Iwabuchi et al.'981. These two patents show the elastic force transmitter employed by the Applicant. Since both King (lines 34,35, column 1) and Iwabuchi (lines 21,22, column 1) are for the same purpose as Palm (preventing high impact load), they are considered to be art recognized equivalents known for the same purpose. It would have been obvious to one of ordinary skill in the art to have modified Butz by employing the elastic force transmitters of King or Iwabuchi instead of the elastic force transmitter of Palm, since they are art recognized equivalents know for the same purpose.

4. Applicant's arguments with regards to the claims are moot in view of the new

grounds of rejection.

Made of record but not relied on is patent to Schultz showing a pertinent reciprocating saw.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KP
May 17, 2006



KENNETH E. PETERSON
PRIMARY EXAMINER